

## RESPONSE AND REMARKS

Claims 1-63 were previously cancelled and Claims 64-79 were previously added to more distinctly claim the invention. Reconsideration of the application in view of the Response and Remarks below are respectfully requested.

The Examiner organized the Office action by numbered topics. In this Response, responsive measures refer to the Office action topic numbers with the abbreviation "Office Action, Topic No. #, p. #".

### REJECTIONS UNDER SECTION 103(a)

In the Office Action, Claims 64-79 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kara et al. (U.S. Patent No. 6,233,568; "Kara") in view of Thiel, "U.S. Patent No. 6,699258"; (U.S. Patent No. 5,699,258; "Thiel").

The Office Action states, with respect to the rejection of Claims 64, and 68-79, that: "Kara discloses the use of shipping management computer system (see abstract) for:"

- a. Receiving a set of package specifications (Fig. 8, Box 802);
- b. Determining multiple shipping rates (first and second) for a first carrier (Fig. 8, Boxes 807 and 808);
- c. Determining multiple shipping rates (third and fourth) for a second carrier (Fig. 8, Boxes 807 and 808);
- d. Receiving a request from a user to ship a package using one of the services by one of the carriers (See Fig. 8, Col. 5, lines 56-67);
- e. Facilitating the delivery of the package (Col. 6, lines 1-6).

Office Action, Topic No. 4, pgs. 2-3.

The Office Action further states that "Kara ... fails to disclose the simultaneous display of the rates for each carrier that includes rates of different services...." Office Action, Topic No. 5, p. 3. Thiel is then cited to support of the assertion that "Thiel discloses the use of a system for calculating rates for multiple carriers for multiple services (see abstract), and discloses the computer storing data for the rates of each

Application Serial No. 09/684,869

Amendment and Response to Office Action dated December 20, 2006

service for each carrier in one table (Column 11, lines 1-13)." Office Action, Topic No. 5, p. 3.

According to the Office Action, "Thiel also discloses that the system will walk the user through which service is wanted, however discloses displaying only the final rate for desired service for multiple carriers (Column 11, lines 46-54)." Office Action, Topic No. 5, p. 3. The Office Action then states that although "Kara and Theil [sic] fail to disclose the 'simultaneous' display of shipping charges for each service of each carrier.... It would have been obvious ... to display all charges simultaneously." Office Action, Topic No. 6, p. 3.

The Office Action then concludes by stating that "[t]he way something is displayed, is not considered to be patentable over the prior art of record, therefore it would have been obvious ... to display all the calculated rates simultaneously for comparison purposes." Office Action, Topic No. 6, p. 3.

#### **REMARKS REGARDING SECTION 103(a) REJECTIONS**

The rejections under Section 103(a) have been carefully considered. Applicant(s) respectfully disagree with the rejections for the following reasons and authorities, and respectfully request reconsideration and allowance of Claims 64-69.

#### **A. The Asserted Conclusion of Obviousness is Not Supported by Sufficient Evidence as Required by MPEP §706.02(j) and MPEP §2143**

Applicants respectfully disagree with the above-quoted conclusion in the Office Action that even though "Kara and Theil [sic] fail to disclose the 'simultaneous' display of shipping charges for each service of each carrier.... It would have been obvious ... to display all charges simultaneously." Office Action, Topic No. 6, p. 3.

Moreover, Applicants respectfully disagree that the above-quoted assertion of obviousness is properly supported by sufficient evidence as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143.

Rather, it is respectfully asserted that the Office Action's concession that a simultaneous display as claimed by the rejected Claims is completely absent from the references cited, is strong evidence that such a simultaneous display is not obvious.

*Cf.*, e.g., *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995). "Unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious or anticipated." *Id.*

**B. Thiel does not Support the Asserted Grounds for the Rejections**

It is respectfully asserted, for the reasons given below, that the above-quoted citation to the table of *Thiel* cited (at *Thiel*, col. 11, lines 1-13 (the "*Thiel Table*")) and the assertion by the Office Action that "Thiel discloses the use of a system for calculating rates for multiple carriers for multiple services (see abstract), and discloses the computer storing data for the rates of each service for each carrier in one table (Column 11, lines 1-13) ..." (*Office Action*, Topic No. 5, p. 3), do not support the rejection of Claims 64-79.

In comparing the cited *Thiel Table* to the claimed limitations of Claims 64-79, it is respectfully asserted that the contents of the cited *Thiel Table* and the description by *Thiel* of the use of the cited *Thiel Table* as described by *Thiel* are instructive.

At first glance, the cited *Thiel Table* may appear to provide a simultaneous comparison of rates. However, it is respectfully submitted that under close inspection, the cited *Thiel Table* provides a stored comparison of base rate components, not of shipping rates that have been determined by the claimed system (as claimed for example, by Claim 64).

Specifically, Claim 64 recites, among other things, the following limitations:

determining a first shipping rate, said first shipping rate being a rate that a first carrier would charge to deliver said package to said destination according to a first delivery service;

determining a second shipping rate, said second shipping rate being a rate that said first carrier would charge to deliver said package to said destination according to a second delivery service;

determining a third shipping rate, said third shipping rate being a rate that a second carrier would charge to deliver said package to said destination according to a third delivery service;

determining a fourth shipping rate, said fourth shipping rate being a rate that said second carrier would charge to deliver said package to said destination according to a fourth delivery service;

simultaneously displaying said first, second, third, and fourth shipping rates to said user ...

As compared to storing rates "... to deliver said package to said destination ..." as recited by, e.g., Claim 64, the cited *Thiel Table* is shown as containing shipping feature rate component entries for five (5) different carriers. See *Thiel*, col. 11, lines 1-13. For each of the five (5) different carriers (Carrier 1-5), the cited *Thiel Table* shows a shipping feature rate component entry for each of the following shipping features: Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. *Id.* at col. 11, lines 1-13.

As compared to a simultaneous display of rates "...to deliver said package to said destination ..." as recited by, e.g., Claim 64, it is respectfully submitted that *Thiel* describes the cited *Thiel Table* as a *stored* table of services and fee *components* of various carriers. More specifically, it is respectfully submitted that *Thiel* explains that the cited stored *Thiel Table* is used by the *Thiel* system to "... search[] the carriers which offer the desired services ..." (*Thiel*, col. 11, lines 22-23) and "... [perform] a fee optimization ... to reach the best price ..." (*Thiel*, col. 11, lines 29-30). That is, the cited *Thiel Table* is used by the *Thiel* system to identify carriers that would provide a user-pre-selected delivery service and user-requested shipping features and to calculate shipping rates for shipping a parcel; the cited *Thiel Table* does not contain shipping rates "...to deliver said package to said destination ..." as recited by, e.g., Claim 64.

In summary, in view of the above-described disclosures of *Thiel*, it is respectfully asserted that, as compared to the above-recited limitations of Claim 64 for "... simultaneously displaying said first, second, third, and fourth shipping rates to said user ...", the *Thiel Table* is not displayed at all, but rather is a stored table.

Yet further, as compared to the above-recited limitations of Claim 64 for "... determining a ... shipping rate ... to deliver said package to said destination ...", the *Thiel Table* does not contain shipping rates determined by *Thiel* "... to deliver said package to said destination ...", but rather stores shipment rating components, that are

used by Thiel as input for determinations of shipping rates for delivering particular packages to particular destinations.

**C. Printed Matter Rejection; Non-Obviousness**

Yet further, the final reasoning of the rejections outlined above (that “[t]he way something is displayed, is not considered to be patentable over the prior art of record, therefore it would have been obvious ... to display all the calculated rates simultaneously for comparison purposes ...” (Office Action, Topic No. 6, p. 3)), is taken to be a printed matter rejection under Section 103(a). However, for the reasons given and the authorities cited below, it is respectfully asserted that a printed matter rejection under Section 103(a) is misplaced.

In particular, with regard to the aforementioned “printed matter” rejection, as the Office Action rightfully notes, the rejected claims are directed to computer systems. It is respectfully submitted that computer systems have been well established as being patentable subject matter under 101.

Further still, “... a ‘printed matter rejection’ under [[section]] 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. . . . [The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated.” *In re Lowry*, 32 F.3d at 1583 (quoting Gulack, 703 F.2d at 1385 n.8).

Further yet, “... when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.” Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, (United States Patent and Trademark Office; Official Gazette Notices for November 22, 2005; the “Interim Guidelines”), § II.C (citing Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) (“In determining the eligibility of respondents’ claimed process for patent protection under Sec. 101, their

claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made."); accord *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, \_\_ (Fed. Cir. 1994) ("The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *Gulack*, 703 F.2d at 1385. The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384; see also *Diamond v. Diehr*, 450 U.S. 175, 191 (1981).")

Therefore, even assuming for the sake of argument that a simultaneous display could be argued to constitute printed matter, in view of the mandate by the *Interim Guidelines*, the holding of the Supreme Court in *Diamond*, and the holding of the Federal Circuit in *In re Lowrey*, it is respectfully asserted that, for reasons given further below, the claimed combination of limitations recited by the rejected claims, when considered together, are not obvious in view of the cited references or any of the other references of record.

### 1. Independent Claim 64

In particular, independent Claim 64, for example, is directed to a shipping management computer system; Claim 64 recites limitations for which the claimed shipping management computer system is programmed, including:

receiving, from a user, a set of package specifications for a particular package that is to be delivered to a particular destination;

determining a first shipping rate, said first shipping rate being a rate that a first carrier would charge to deliver said package to said destination according to a first delivery service;

determining a second shipping rate, said second shipping rate being a rate that said first carrier would charge to deliver said package to said destination according to a second delivery service;

determining a third shipping rate, said third shipping rate being a rate that a second carrier would charge to deliver said package to said destination according to a third delivery service;

determining a fourth shipping rate, said fourth shipping rate being a rate that said second carrier would charge to deliver said package to said

destination according to a fourth delivery service;

simultaneously displaying said first, second, third, and fourth shipping rates to said user; and

receiving a request from said user to ship said package to said destination via a particular delivery service, said particular delivery service being selected from a group consisting of: (A) said first delivery service; (B) said second delivery service; (C) said third delivery service, and (D) said fourth delivery service; and

facilitating delivery of said package to said destination via said particular delivery service.

Even assuming for the sake of argument that a simultaneous display could be argued to constitute printed matter, in view of the mandate to consider all limitations of a Claim by the *Interim Guidelines*, the holding of the Supreme Court in *Diamond*, and the holding of the Federal Circuit in *In re Lowrey*, it is respectfully asserted that the combination of determining first, second, third and fourth shipping rates as recited by independent Claim 64, and then simultaneously displaying those rates, and then receiving a request from a user to ship a package where, as claimed by Claim 64, the “particular deliver service being selected from ...” on of the delivery services for which rates were calculated, and then facilitating delivery of the package as claimed by Claim 64, are limitations, the combination of which is not disclosed, anticipated, taught or suggested by any combination of the references of record, including *Kara* and *Thiel*.

It is respectfully asserted that one advantage of a shipping management computer system according to various embodiments of the system claimed in Claim 64 is that such embodiments allow for a simultaneous display, and therefore a simultaneous cross-comparison by a user, of the various rates associated with multiple delivery services provided by each of a plurality of carriers. For example, such a system could be configured for simultaneously displaying: (1) the shipping rate that UPS would charge to deliver a package via overnight delivery; (2) the shipping rate that UPS would charge to deliver the package via second day delivery; (3) the shipping rate that Federal Express would charge to deliver a package via overnight delivery; and (4) the shipping rate that Federal Express would charge to deliver the package via second day delivery. Such a display may be useful in allowing users to quickly compare the delivery services (and associated rates) of various carriers.

For the above-given reason and authorities, it is respectfully asserted that the above-cited limitations of independent Claim 64 are not disclosed, anticipated, taught or suggested by either *Thiel* or *Kara*, whether considered alone or in combination with any other reference of record.

**2. Independent Claim 74**

For reasons similar to those described above with respect to Claim 64, it is respectfully asserted that neither *Thiel* nor *Kara*, whether considered alone or in combination with any other reference of record, disclose, anticipate, teach or suggest all of the limitations of Claim 74. Independent Claim 74 is directed to a shipping management computer system that is programmed for:

identifying a first day on which a first carrier would deliver a particular package to a particular destination if said first carrier were to deliver said package to said destination via a first delivery service;

identifying a second day on which said first carrier would deliver said package to said destination if said first carrier were to deliver said package to said destination via a second delivery service;

identifying a third day on which a second carrier would deliver said package to said destination if said second carrier were to deliver said package to said destination via a third delivery service;

identifying a fourth day on which said second carrier would deliver said package to said destination if said second carrier were to deliver said package to said destination via a fourth delivery service; and

simultaneously displaying to a user:

(A) a first delivery schedule indicia indicating that said first carrier would deliver said package to said destination on said first day if said first carrier were to deliver said package to said destination via said first delivery service;

(B) a second delivery schedule indicia indicating that said first carrier would deliver said package to said destination on said second day if said first carrier were to deliver said package to said destination via said second delivery service;

(C) a third delivery schedule indicia indicating that said second carrier would deliver said package to said destination on said third day if said second carrier were to deliver said package to said destination via said third delivery service; and

(D) a fourth delivery schedule indicia indicating that said second carrier would deliver said package to said destination on said fourth day if said second carrier were to deliver said package to said destination via said fourth delivery service.

As compared to the above-recited limitations of independent Claim 74 for "... identifying a ... day on which a ... carrier would deliver a particular package to a particular destination ...", the stored Thiel Table cited by the Office Action at column 11, lines 1-13 merely lists, for five (5) different carriers, such shipping features as Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. Thiel, col. 11, lines 1-13. It is respectfully submitted that no dates or times are listed in the stored Thiel Table.

Further, it is respectfully asserted that the listing in the cited stored Thiel Table of "Express Delivery" as a setting for each of five carriers, does not constitute "...identifying a ... day on which a ... carrier would deliver a particular package to a particular destination if said ... carrier were to deliver said package to said destination via a ... delivery service ..." as recited by Claim 74 for various carriers and various delivery services. That is because, depending on each carrier's rules, the mere listing of an offering of a delivery service, such as an Express Delivery service, does not necessarily indicate any particular date for delivery. For example, if a shipment is initiated on a Friday, a weekend, or a day preceding a holiday, depending on a given carrier's rules regarding Saturday, Sunday, or holiday delivery, the shipment may not, be delivered by an Express Service on the day following the date on which the shipment was initiated.

Yet further, it is respectfully submitted that Kara does not disclose a display of a day on which a carrier would deliver a particular parcel as recited by Claim 74. For the reasons described above with respect to Thiel, it is respectfully similarly asserted that Kara's display of such delivery services as "Overnight", "Next Day", and the like, does not constitute a display of a day on which a parcel would be delivered. For example, even if a user of the Kara system were to indicate the "Same Day" option, a display by Kara of the rates for that service level would not, depending on the drop-off or pick-up time of the package, indicate the day of delivery.

Still further, analogous to the reasons given above with respect to independent Claim 64, it is respectfully submitted that the stored *Thiel Table* is not displayed to the user, and therefore would not be properly held to disclose the limitations of Claim 74 for "...simultaneously displaying to a user ... delivery schedule indicia ...."

It is respectfully asserted that one advantage of a shipping management computer system according to various embodiments of the system claimed in new Claim 74 is that such embodiments allow for a simultaneous cross-comparison of the various schedules according to which a package would be delivered via multiple delivery services provided by each of a plurality of carriers. For example, such a system could be configured for simultaneously displaying: (1) the date on which UPS would deliver a package via an "overnight" delivery service; (2) the date on which UPS would deliver the package via a "second day" delivery service; (3) the date on which Federal Express would deliver the package via an "overnight" delivery service; and (4) the date on which Federal Express would deliver the package via a "second day" delivery service. Such a display may be useful in allowing users to quickly compare the dates on which a package would actually be delivered if the user were to send the package via various delivery services. This can be especially useful if different carriers have different policies regarding, for example, whether a package sent via overnight delivery on a Friday would be delivered on the next weekday (Saturday) or on the next business day (Monday).

For the above-given reason and authorities, it is respectfully asserted that the above-cited limitations of independent Claim 74 are not disclosed, anticipated, taught or suggested by either *Thiel* or *Kara*, whether considered alone or in combination with any other reference of record.

**D. No Showing Under MPEP §2143 For Each Limitation of Each Claim.**

It is respectfully asserted that the rejections did not indicate, as required under MPEP §2143, how the cited references, even when combined, disclose, anticipate, teach or suggest each of the limitations of each of the rejected Claims.

For example, independent Claim 74 of the present application recites limitations for which the rejections failed to indicate, as required under MPEP §2143, any

disclosure, anticipation, teaching or suggesting by the cited references, even when combined. Specifically, for example, independent claim 74 recites "... identifying a ... day on which a ... carrier would deliver a particular package to a particular destination ...." Yet the Office Action failed to assert any reference or combination of references regarding a disclosure, anticipation, teaching or suggestion of the claimed limitations regarding "... identifying a ... day on which a ... carrier would deliver a particular package to a particular destination ...."

As another example, dependent Claim 79 recites "...a ... time ... before which said first carrier would deliver said package to said destination if said first carrier were to deliver said package to said destination via said first delivery service ...." Yet the Office Action failed to assert any reference or combination of references regarding a disclosure, anticipation, teaching or suggestion of the claimed limitations regarding time.

**E. Unsupported Reference to "Barnett"**

In rejecting Claim 67 under §103(a), it is respectfully submitted that the Office Action mentions "Barnett," but fails to identify the Barnett reference with any further particularity, or to provide any discussion regarding the reasoning for citing it.

**CONCLUSION**

Because, as respectfully asserted above, neither Kara nor Thiel, disclose, anticipate, teach or suggest all of the limitations of independent Claims 64 and 74, it is respectfully asserted that neither Kara nor Thiel, disclose, anticipate, teach or suggest all of the limitations of the claims that are dependent on Claims 64 and 74.

For the foregoing reasons and authorities, it is respectfully asserted that the

Application Serial No. 09/684,869

Amendment and Response to Office Action dated December 20, 2006

invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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